

Dkt. No. 60390-AZ-PCT-US/JPW/GJG/NDP

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicants : Arlindo L. Castelhana et al.  
Serial No. : 10/816,329 Examiner: T. McKenzie  
Filed : March 31, 2004 Group Art Unit: 1624  
For : 4-HETEROCYCLO-PYRROLO [2,3d] PYRIMIDINE  
COMPOSITIONS AND THEIR USE

1185 Avenue of the Americas  
New York, New York 10036

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**TERMINAL DISCLAIMER**

Petitioner OSI Pharmaceuticals, Inc., having a place of business at 41 Pinelawn Road, Melville, NY 11747, the sole assignee of record of the entire right, title, and interest in and to the above-identified application by virtue of an Assignment from Arlindo L. Castelhana, Bryan McKibben and David J. Witter, recorded with the United States Patent and Trademark Office on March 26, 2001 at Reel 011704, Frames 0888-0892, a copy of which is attached hereto as **Exhibit 1**, hereby disclaims, except as provided below, the terminal portion of the statutory term of any patent granted on the subject application which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. §154 to §156 and §173 of commonly assigned U.S. Patent Nos. 6,664,252, 6,680,324 and 6,800,633.

Petitioner hereby agrees that any patent granted on the subject application shall be enforceable only for and during such period that U.S. Patent Nos. 6,664,252, 6,680,324 and 6,800,633 are commonly owned and that this agreement will run with any patent granted on the subject application and be binding upon the grantee, its successors and assigns.

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03 FC:1814

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Applicants: Arlindo L. Castelhana et al.  
Serial No.: 10/816,329  
Filed: March 31, 2004  
Exhibit A

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Applicants: Arlindo L. Castelhana et al.  
Serial No.: 10/816,329  
Filed : March 31, 2004  
Page 2

In making the above disclaimer, Petitioner does not disclaim the terminal portion of any patent granted on the subject application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. §154 to §156 and §173 of U.S. Patent Nos. 6,664,252, 6,680,324 and 6,800,633 in the event that such patent later expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. §1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term.

I certify that I have reviewed the attached Assignment, and that, to the best of my knowledge and belief, OSI Pharmaceuticals, Inc.: have the entire right, title and interest in and to the subject application. I further certify that I am authorized to sign this Terminal Disclaimer on behalf of OSI Pharmaceuticals, Inc. as indicated.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that any such willful false statement may jeopardize the validity of the application or any patent issued thereon.

OSI PHARMACEUTICALS, INC.

Date: May 15, 2006

By: Barbara A. Wood

Barbara A. Wood, Esq.  
Vice President and General Counsel



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
ASSISTANT SECRETARY AND COMMISSIONER  
OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

JULY 02, 2001

PTAS

COOPER & DUNHAM LLP  
JOHN P. WHITE, ESQ.  
1185 AVENUE OF THE AMERICAS  
NEW YORK, NEW YORK 10036



\*101685534A\*

UNITED STATES PATENT AND TRADEMARK OFFICE  
NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT

THE ENCLOSED DOCUMENT HAS BEEN RECORDED BY THE ASSIGNMENT DIVISION OF THE U.S. PATENT AND TRADEMARK OFFICE. A COMPLETE MICROFILM COPY IS AVAILABLE AT THE ASSIGNMENT SEARCH ROOM ON THE REEL AND FRAME NUMBER REFERENCED BELOW.

PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT DIVISION, BOX ASSIGNMENTS, CG-4, 1213 JEFFERSON DAVIS HWY, SUITE 320, WASHINGTON, D.C. 20231.

RECORDATION DATE: 03/26/2001

REEL/FRAME: 011704/0888  
NUMBER OF PAGES: 4

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:

CASTELHANO, ARLINDO L.

DOC DATE: 02/06/2001

ASSIGNOR:

MCKIBBEN, BRYAN

DOC DATE: 02/05/2001

ASSIGNOR:

WITTER, DAVID J.

DOC DATE: 02/05/2001

ASSIGNEE:

OSI PHARMACEUTICALS, INC.  
106 LINDBERGH BLVD.  
UNIONDALE, NEW YORK 11553-3649

SERIAL NUMBER: 09728229  
PATENT NUMBER:

FILING DATE: 12/01/2000  
ISSUE DATE:

Applicants: Arlindo L. Castelhana et al.  
Serial No.: 10/816,329  
Filed: March 31, 2004  
Exhibit 1

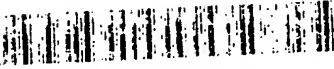
011704/0888 PAGE 2

MARY BENTON, EXAMINER  
ASSIGNMENT DIVISION  
OFFICE OF PUBLIC RECORDS

04-25-2001

L. No. 1919/60390-A-PCT-US

JPW/GJG/CMR



## RECORDATION FORM COVER SHEET

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## PATENTS ONLY

Patent and Trademark Office

101685534

Patents and Trademarks. Please record the attached original documents or copy thereof.

## 1. Name of conveying party(ies):

Arlindo L. Castelhanos  
Bryan McKibben  
David J. Witter

3.76.01

Additional name(s) of conveying party(ies) attached?

☐ Yes ☒ No

## 3. Nature of Conveyance:

- ☒ Assignment  
☐ Security Agreement  
☐ Other \_\_\_\_\_
- ☐ Merger  
☐ Change of Name

Execution Date(s): 2/6/01, 2/5/01, 2/5/01

## 2. Name and address of receiving party(ies):

Name: OSI PHARMACEUTICALS, INC.

Internal Address: \_\_\_\_\_

Street Address: 106 Lindbergh Blvd.

City/State/Zip: Uniondale, N.Y., 11553-3649

Additional name(s) & address(es) attached? ☐ Yes ☒ No

4. Application number(s) or patent number(s): If this document is being filed together with a new application, the execution date(s) of the application is(are):

A. Patent Application No.(s) 09/728,229

Filed: 12/1/00

B. Patent No.(s) \_\_\_\_\_

Additional numbers attached?

☐ Yes ☒ No

5. Name and address of party to whom correspondence concerning document should be mailed:

Name: John P. White, Esq.

Internal Address: \_\_\_\_\_

Street Address: Cooper &amp; Dunham LLP

1185 Avenue of the Americas

City/State/Zip: New York, New York 10036

6. Total number of applications and patents involved: 1

7. Total fee (37 CFR §3.41): \$ 40.00

☐ Enclosed

☒ Authorized to be charged to deposit account

8. Deposit account number:

03-3125

DO NOT USE THIS SPACE

## 9. Statement and signature.

To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.

John P. White

Name of Person Signing

Signature

March 21, 2001

Date

I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231.

John P. White  
Registration No. 28,678

Date

Total Number of pages including cover sheet, attachments and document: 4

OMB No. 0651-0011 (exp. 4/94)

Mail documents to be recorded with required cover sheet information to:

Commissioner of Patents and Trademarks  
Box Assignments  
Washington, D.C. 20231

# Assignment

In consideration of One Dollar (\$1.00), and other good and valuable considerations, the receipt of which is hereby acknowledged, I, the undersigned, Arlindo L. Castelhana residing at 3 Eagle Court, New City, New York 10579, USA; Bryan McKibben residing at Apartment 8, 15 Greenridge Avenue, White Plains, New York 10605, USA; and David J. Witter residing at 12 Arbutus Road, Putnam Valley, New York 10579, USA

Hereby sell, assign and transfer to OSI Pharmaceuticals, Inc.

a corporation of the State of

New York

having a place of business at 106 Charles Lindbergh Blvd.

in the County of Nassau

and State of New York 11553-3649

its successors, assigns and legal representatives, the entire right, title and interest for all countries, in and to any and all inventions which are disclosed and claimed,

and any and all inventions which are disclosed but not claimed, in the application for

United States Patent, which has been executed by the undersigned

February 6, 2001

and is entitled

February 5, 2001

February 5, 2001

PYRROLO[2,3d]PYRIMIDINE COMPOSITIONS AND THEIR USE

(U.S. Serial No. 09/728,229 Filed December 1, 2000, a continuation of PCT International Application No. PCT/US99/12135, filed June 1, 1999 claiming priority of U.S. Provisional Application No. 60/087,702, filed June 2, 1998, U.S. Provisional Application No. 60/123,216, filed March 8, 1999 and U.S. Provisional Application No. 60/126,527, filed March 26, 1999)

and in and to said application and all divisional, continuing, substitute, renewal, reissue, and all other applications for U.S. Letters Patent or other related property rights in any and all foreign countries which have been or shall be filed on any of said inventions disclosed in said application; and in and to all original and reissued patents or related foreign documents which have been or shall be issued on said inventions;

Authorize and request the Commissioner of Patents of the United States to issue to said Assignee, the corporation above named, its successors, assigns and legal representatives, in accordance with this assignment, any and all United States Letters Patent on said inventions or any of them disclosed in said application;

Agree that said Assignee may apply for and receive foreign Letters Patent or rights of any other kind for said inventions, or any of them; and may claim, in applications for said foreign Letters Patent or other rights, the priority of the aforesaid United States patent application under the provisions of the International Convention of 1883 and later modifications thereof, under the Patent Cooperation Treaty, under the European Patent Convention or under any other available international agreement; and that, when requested, without charge to, but at the expense of, said Assignee, its successors, assigns and legal representatives, to carry out in good faith the intent and purpose of this assignment, the undersigned or the undersigned's executors or administrators will, for the United States and all foreign countries execute all divisional, continuing, substitute, renewal, reissue, and all other patent applications, or other documents on any and all said inventions; execute all rightful oaths, assignments, powers of attorney and other papers; communicate to said Assignee, its successors, assigns and representatives, all facts known and documents available to the undersigned relating to said inventions and the history thereof; testify in all legal proceedings; and generally do everything possible which said Assignee, its successors, assigns or representatives shall consider desirable for aiding in securing, maintaining and enforcing proper patent protection for said inventions and for vesting title to said inventions and all applications for patents or related foreign rights and all patents on said inventions, in said Assignee, its successors, assigns and legal representatives; and

Covenant with said Assignee, its successors, assigns and legal representatives that no assignment, grant, mortgage, license or other agreement affecting the rights and property herein conveyed has been made to others by the undersigned, and that full right to convey the same as herein expressed is possessed by the undersigned.

Date: Feb. 6, 2007 20

Witness: Sharon Norbeck  
SHARON NORBECK  
1799 Lockwood Rd  
McKean Lake NY 10547

Arlindo L. Castel (L.S.)

Arlindo L. Castelhana

Date: Feb 5 2007

Witness: Sharon Norbeck  
SHARON NORBECK  
1799 Lockwood Road  
McKean Lake NY 10547

Bryan McKibben (L.S.)

Bryan McKibben

David J. Witter (L.S.)

Date: Feb 5 2001 David J. Witter

Witness: Sharon Norbeck

SHARON NORBECK

1799 LOCKWOOD Rd

Monrovia Lake NY 10547



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ASSIGNMENT  
BY

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ARLINDO L. CASTELHANO  
BRYAN MCKIBBEN  
DAVID J. WITTER

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TO

OSI PHARMACEUTICALS, INC.

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Application for Letters Patent of  
the United States for:

PYRROLO[2,3d] PYRIMIDINE  
COMPOSITIONS AND THEIR USE

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Attorney ~~FOR~~ John P. White

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